

Appl. No. 10/608,680
Reply to Office action of 10/01/2004

REMARKS

Claims 1-9 and 19 are in condition for allowance and claims 10-18 and 20 are rejected. Applicant respectfully amends claims 8, 17 and 20, adds new claims 21 and 22, and cancels claims 6 and 15. Claims 6 and 15 are not canceled for patentability or functional reasons and are still applicable as an embodiment of the present invention as claimed. Applicant respectfully submits that the claims as originally presented and as presented in this amendment and response are in condition for allowance.

The examiner has rejected claims 10-18 and 20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 1, respectively, of U.S. Patent No. 6,325,150 in view of U.S. Patent No. 6,056,292. The examiner concludes that although the conflicting claims are not identical, they are not patentably distinct from each other. Applicant respectfully submits that claims 10-18 and 20 are not anticipated by Applicant's U.S. Patent No. 6,325,150 nor is applicant's claimed invention obvious or anticipated in view of the '292 patent.

The examiner states that the rejection is based on the rationale in *In re Goodman*, stating "where Applicant has once been granted a patent containing a claim for the specific or narrower invention, Applicant may not then obtain a second patent with a claim for the generic or broader invention." The examiner states that "since Application claim 10 is anticipated by claim 1 of U.S. Pat. No. 6,325,150, and since anticipation is the epitome of obviousness, then Application claim 10 are (*sic*) obvious over claim 1 of U.S. Pat. No. 6,325,150."

Applicant respectfully submits that Applicant's claim 10 is not anticipated by the '150 patent, and the '150 patent does not contain claims "for the specific or narrower invention" as that of Application claim 10. The '105 Patent claim 1 is the "generic or broader invention."

As set-out in the specification of the application, the present invention addresses a wave seal to resist extrusion during equalization. Application claims 10 and 20 include the limitation that the seals have "a wave-like geometry." Application claims 10 and 20 are therefore *narrower* and for a *species* of the '150 Patent claim 1. The examiner has reversed, or turned upside down,

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the rationale of *In re Goodman* the examiner. The rationale of *In re Goodman* is not applicable and the rejection is unfounded. Application claims 10 and 20 are patentably distinct from the '105 Patent claim 1. Applicant respectfully requests that the rejection be withdrawn and the claims be allowed for issuance.

The examiner has further rejected Application claims 10 and 20 as obvious over Applicant's '150 Patent claim 1 in view of the '292 patent to Gerigk. To justify the combination the examiner simply states "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the seal of Application claim 10 by having a seal with wave-like geometry as taught by Gerigk in order for there to be more sealing surface area on the shaft to increase the effective sealing area."

"A double patenting rejection of the obviousness-type is 'analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103' except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination." MANUAL OF PATENT EXAMINING PROCEDURE § 804(II)(B)(1).

Applicant respectfully submits that the combination of the '105 Patent and the '292 Patent does not anticipate all of the claimed elements of Applicant's claimed invention. Applicant further respectfully submits that the examiner has failed to provide *prima facie* showing of obviousness. Before a claim may be rejected under section 103, the examiner must establish a *prima facie* case of obviousness. See MANUAL OF PATENT EXAMINING PROCEDURE §§ 804 and 2142.

The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18; 148 USPQ 459, 467 (1966).

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"[W]hen the issue is obviousness, 'it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section.' *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ2d 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

'The factual inquiry whether to combine references must be thorough and searching.' *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined *only* if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggest the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fitch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the

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examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.')." *In re Lee*, 61 USPQ2d 1430, 1433-34, (CAFC 2002).

First, the examiner has simply stated "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the seal of Application claim 10 by having a seal with wave-like geometry as taught by Gerigk in order for there to be more sealing surface area on the shaft to increase the effective sealing area" to justify the combination. Rather than pointing to specific teachings in the '150 or '292 patent that suggest combination the examiner instead described similarities with the claimed invention. The examiner does not "particularly identify any suggestion, teaching, or motivation to combine" the cited references nor does the examiner "make specific, or even inferential, findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Further, in the examiner's justification for the rejection, the examiner misstates the purpose of the '292 patent. The examiner states, in part, that it would be obvious to "modify the seal of Application claim 10 by having a seal with wave-like geometry as taught by Gerigk in order for there to be more sealing surface area on the shaft to increase the effective sealing area." Gerigk teaches "a generic type shaft seal to permit improved lubrication of the seal surface." Column 2, lines 42-43. "[L]ubricant collects in the wave indentations on the lubrication side which is then carried into the seal gap as a result of the rotational movement of shaft 2." Column 4, lines 35-38. No where does the '292 patent teach providing a greater sealing surface area nor teach or suggest addressing Applicant's invention of extrusion during equalization. Therefore, even the examiner's conclusory and cursory justification for combination is flawed and indicates the nonobviousness of Applicant's claimed invention.


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Applicant respectfully submits that the examiner has failed to provide a *prima facie* showing of obviousness and thus Applicant's claims 1 through 22 are in condition for allowance. Applicant respectfully requests that the examiner withdraw the rejections and allow the claims for issuance.

Respectfully submitted,
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December 13, 2004
DATE

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